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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/943,061	08/30/2001	Aalim Lakhani	CA92000005GUS1/2178P	8697
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IBM ST-SVL SAWYER LAW GROUP LLP 2465 E. Bayshore Road, Suite No. 406 PALO ALTO, CA 94303			EXAMINER CHEN, TE Y	
			ART UNIT 2161	PAPER NUMBER
			NOTIFICATION DATE 08/17/2009	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patent@sawyerlawgroup.com

Office Action Summary**Application No.**

09/943,061

Applicant(s)

LAKHANI ET AL.

Examiner

SUSAN Y. CHEN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Nov. 04, 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

Response to Amendment

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114 was filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 11/04/2008 has been entered.

This office action is in response to the amendment filed on Nov. 04, 2008.

Claims 1-25 are pending for continued examination. Claims 1, 10, 15, 17 have been amended.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

The instant specification failed to clearly define the claimed subject matter "computer-readable storage medium", as such, the claimed subject matter is lacking of antecedent basis.

Claim Objections

Claims 18 -25, are objected to because of the following informalities:

As to claims 18-25, these dependent claims have a leftover typing error (i.e., the claimed "signal-baring medium" should be changed to "computer-readable storage medium", because the independent claim for these claims recites a "computer-readable storage medium".)

Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-25 are rejected under 35 U.S.C. 101, because the claimed invention is directed to non-statutory subject matter.

As to claim 1, this system claim recite a virtual computer system for enabling the purchase of a package in the preamble, however, the body of the claim fails to include any physical or hardware machine to really execute the claimed purchasing of a package, hence, the claimed system merely direct to be software per se. In re Bilsky.

As to claim 10, this method claim failed to use any physical processor in the claimed body to transform the claimed abstract steps of any underlying tangible matter to a different state or thing, thus, the claimed method merely represent an abstract idea. In re Comiskey.

As to claims 15 and 17, these claim recited "a computer readable storage medium", however, as set forth above, the claimed "a computer readable storage medium" is not defined in the instant specification. Since a computer readable storage medium could contain virtual storage medium, which renders the claimed product as non-statutory.

As to claims 2-9, 11-14, 16 and 18-25, these claims failed to resolve the defects in their base claims respectively, as such, they are rejected for the same reason.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 10, 15 and 17, are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 7 and 10 of U.S. Patent No. 7,174,508. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Claims 1, 10, 15 and 17 of the present application merely repeat the features of claims 1, 7 and 10 of U.S. Patent No. 7,174,508 with less conventional details.

However, it is obvious for an ordinary skilled person in the art at the time the invention was made to modify the narrower claims of 7,174,508 with common details for the purpose to extend a more broader intentional usage for his/hers invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mikurak (U.S. Patent No. 6,606,744) in view of Wyatt (U.S. Patent No. 6,041,411).

As to claim 1, Mikurak discloses an e-commerce system [e.g., Fig. 4] for enabling the purchase of a package of products and services [e.g., Fig(s). 54-55], comprising:

a) a catalog database [e.g. see the modules 5300, 5324 of Fig. 53; Fig. 80; the Application Database of Fig. 121] comprising package data correlated to at least one package [e.g. see col. 178, lines 19-46].

b) a selection module coupled to the catalog database for allowing a customer to select a package for purchase [e.g. see the shopping Cart processing at col. 96 et seq., Fig. 55].

c) a resolution module coupled to the catalog database for resolving unresolved attributes of the one or more products in the selected unresolved package [e.g. see the Problem Handling process 1502, Fig. 21; col. 46, lines 54 – col. 48, lines 41].

Mikurak did not expressly disclose that resolving the unresolved attribute of products in a package is by matching a selected catalog entry identifier with a package identifier.

However, Wyatt disclosed an e-commerce system has details as claimed [e.g., Abstract, Fig(s). 5-10 and associated texts].

Mikurak and Wyatt are in the same field of providing a resolution module to resolve the problems occurred in an e-commerce system. Thus, with the teachings of Mikurak and Wyatt in front of him/her, a ordinary skilled person in the art, at the time the invention was made would be motivated to modify Mikurak's resolution module with the technique taught by Wyatt, because by doing so, the combined system will provide a resolving module to verify and matching a selected catalog entry identifier with a package identifier such that the ordered product is to be automatically launched upon purchase [e.g., Wyatt: col. 10, lines 30 – 40].

As to claim 2, the combined system further discloses the catalog database comprising item data, product data and attribute data [e.g., Mikurak: the Item catalog screen processing, col. 97, line 49 – 59; Wyatt: Fig.(s) 5-7].

As to claim 3, the combined system further discloses the catalog database comprising image data correlated to at least one package [e.g., see Mikurak: the on-line display of purchase list, col. 28, lines 21-23; col. 97, lines 55-56].

As to claims 4-5, the combined system further discloses the system connected to a global communication network – Internet [e.g., see Mikurak: the network (135), Fig. 1].

As to claims 6-9, the combined system further discloses the system comprising catalog database, selection module, resolution module, ordering module, and payment module [e.g., see Mikurak: Fig. 4, Fig(s). 20-27].

As to claims 10-16, these claims recite similar features as claims 1-9 in form of e-commerce processing method, hence are rejected for the same reason.

As to claims 17-25, these claims recited similar features as claims 1-15 in form of computer readable product implemented in multimedia signal-baring medium, via modulated carrier signal transmission over a network/internet [e.g., see Mikurak: Abstract, lines 1-12]. Thus, they are rejected for the same reason.

Response to Arguments

Applicant's arguments filed on Nov. 04, 2008 have been fully considered but they are not persuasive.

The examiner disagrees with applicant arguments based on newly amended limitations under the 35 U.S.C. 101 rejections.

In response to applicant arguments, the examiner directs applicant's attention to the 35 U.S.C. 101 rejections set forth above. Furthermore, because applicant failed to specifically disclose any physical machine to perform the claimed "purchase of a package" or transform the claimed body steps into different state or thing; in addition, the claimed "computer readable storage medium" is not clearly defined and seemed to

include transmitting signal [e.g., Specification: 0008], which represents a form of energy, thereby, the invention as a whole merely directs to non-statutory.

Based on the discussion above, because applicant does not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections or rejections, therefore, it is believed that the rejections on record should be sustained.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Stern (U.S. Patent No. 6,591,247) which disclosed an advertising method and system for disseminating information concerning multiple products over Internet.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SUSAN Y. CHEN whose telephone number is (571)272-4016. The examiner can normally be reached on Monday - Friday from 7:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mofiz Apu can be reached on 571-272-4080. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Susan Y Chen/
Partial Sig. Examiner
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July 12, 2009